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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204861
Party	Plaintiff Red Bull GmbH
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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that Opposer's Opposition to Applicant's Motion for Partial Judgment on the Pleadings is being filed with the TTAB via ESTTA on the date set forth below.

Date: April 30, 2014

/Leah Z. Halpert/

Leah Z. Halpert

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<hr style="border: 1px solid black;"/> RED BULL GMBH,)	Consolidated Matter: 91-204,861
)	Opposition No. 91-204,861
)	Opposition No. 91-210,860
Opposer,)	
)	Marks:
v.)	ANDALE! ENERGY DRINK & Des (#85/334,836)
)	ANDALE! (#85/646,359)
JEAN PIERRE BIANE and)	ANDALE! (#85/646,316)
ANDALE ENERGY DRINK CO)	
LLC,)	Serial Nos. :
)	85/334,836
Applicant.)	85/646,359
)	85/646,316
<hr style="border: 1px solid black;"/>		

**OPPOSER'S OPPOSITION TO APPLICANT'S FIRST MOTION FOR PARTIAL
JUDGMENT ON THE PLEADINGS**

Opposer, RED BULL GMBH ("Opposer") submits this brief in opposition to Applicant's Motion for Partial Judgment on the Pleadings ("MPJP")¹. A motion for judgment on the pleadings is based solely on a review of a pleadings, however, Applicant's MPJP does not mention the pleadings at all, or even identify which facts, all of which in the Notice of Opposition ("Complaint") are deemed admitted for the purposes of this motion, it relies upon to support its motion. Rather the MPJP makes only unsupported, conclusory statements of opinion, ignoring the fact that even a cursory review of the pleadings – and Applicant's extensive disputing of the facts – clearly shows that all material factual allegations are in dispute, with the only undisputed allegations dealing with the ownership of and the contents of the PTO records

¹ The MPJP deals solely with opposed Appln. No. 85/646,359. Therefore, Opposer's response is also limited to only Appln. No. 85/646,359. Nothing herein should be construed to represent Opposer's arguments, case, or evidence pertaining to the other two opposed applications not at issue in this Motion, and does not address Applicant's later filed (on April 25, 2014) second motion for partial judgment on the pleadings.

for the respective marks.² Based on this alone, it is clear that whether Applicant is entitled to judgment as a matter of law cannot be determined by the pleadings alone, and the instant Motion must be denied³.

Additionally, Applicant's reliance on *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), upon which the entire MPJP is based, is misplaced, as the *Kellogg* case presents a standard for a motion for summary judgment, not a motion for judgment on the pleadings.

A. The Relevant Factual Allegations in Opposer's Opposition Must be Accepted as True for Purposes of this Motion.

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all of the pleadings, supplemented by any facts of which the Board will take judicial notice.⁴ For purposes of the motion, all well-pleaded factual allegations of the nonmoving party (in this case, Opposer) must be accepted as true, while those allegations of the moving party (Applicant) which have been denied are deemed false⁵ If, upon review of the pleadings, the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment, the motion for judgment on the pleadings must be denied.⁶

When deeming all factual allegations in the Complaint as true – as must be done in accordance with the rules – it becomes apparent that Opposer would be entitled to judgment if these issues of fact are proven. As Applicant has limited its Motion to only a comparison of the marks (and has voluntarily conceded every other *DuPont* factor in Opposer's favor⁷), only the

² Applicant's Answer, Docket No. 4, Oppo No. 91-210,860, ¶¶ 2, 4, 8-11, 12 (in part) (July 8, 2013).

³ "A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved" *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91195033 (TTAB September 5, 2011) (emphasis added).

⁴ *Kraft Group LLC v. Harpole*, 90 USPQ2d at 1840; *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008).

⁵ *Id.*

⁶ *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983).

⁷ See MPJP at 3.

following facts alleged in Opposer's Complaint are relevant for the purposes of the MPJP and need be addressed at this time:

Opposer is now and has for many years been engaged in the development, marketing, advertising, distribution and sale of various products and services including, among others, energy drinks, sports drinks, soft drinks, beverages, and various other products and services related or complementary thereto.⁸

Opposer owns the valid and subsisting U.S. trademark Reg. No. 2,829,269 for the design mark below (hereinafter referred to as the "Red Bull Graphics Mark"), which was registered on the Principal Register on April 6, 2004 and currently covers "Non-alcoholic beverages, namely, soft drinks, sports drinks, energy drinks". Color is not claimed as a feature of the Reg. No. 2,829,269, and as such the registration protects this design in any color combination⁹:



Since long prior to the June 7, 2012 filing dates of Applicant's Opposed Marks, Opposer has continuously used the Red Bull Graphics Mark in interstate commerce on or in connection with "non-alcoholic beverages, namely, soft drinks, sports drinks, energy drinks."¹⁰

On March 29, 2010, Opposer filed a combined Sec. 8 Affidavit of Use and Sec. 15 Declaration of Incontestability for the Red Bull Graphics Mark in connection with "Non-alcoholic beverages, namely, soft drinks, sports drinks, energy drinks", which was accepted and acknowledged on April 8, 2010.¹¹

Opposer's Red Bull Graphics Mark has become a valuable asset of Opposer, identifying its energy drinks, sports drinks, soft drinks, beverages, and various other products and services related or complementary thereto, and distinguishing Red Bull's products and services from the products and services of others.¹²

Opposer's Red Bull Graphics Mark has been extensively advertised in the United States and throughout the world, and has appeared on or in relation to products, product packaging, point-of-sale displays and other promotional materials for products sold, offered and advertised, and/or have been used in connection with energy drinks, sports drinks, soft drinks, beverages, and various other products and services related or complementary thereto advertised, offered, conducted and/or promoted in the United States and throughout the world.¹³

In 2012 alone, sales of RED BULL beverages exceeded 5.2 billion units, with over 1.9 billion units sold in the United States. As a result of the enormous success and sales of Opposer's beverages and of the extensive advertising and promotion of Opposer's Red Bull Graphics Mark on products such as energy drinks, sports drinks, soft drinks, beverages, and various other products and services related or complementary thereto in the United States and throughout the

⁸ Complaint, Docket No. 1, Oppo No. 91-210,860, ¶ 1 (May 29, 2013) ("Complaint").

⁹ *Id.* at ¶ 2.

¹⁰ *Id.* at ¶ 3.

¹¹ *Id.* at ¶ 4.

¹² *Id.* at ¶ 5.

¹³ *Id.* at ¶ 6.

world, the Red Bull Graphics Mark has become and is a famous mark, and is recognized in the United States and elsewhere as such, and Opposer's name and identity have become and are famous, and are recognized in the United States and elsewhere as such.¹⁴

Applicant filed Appln. No. 85/646,359 on June 7, 2012, for the trademark ANDALE! & Design based on an intent-to-use the mark in commerce on the Int. Class 32 goods set forth in said application, namely, "Non-alcoholic beverages, namely, energy drinks, energy shots, sports drinks, soft drinks, and bottled water." Appln. No. 85/646,359 does not claim color as a feature of the mark, such that Applicant could use its ANDALE! & Design mark of Appln. No. 85/646,359 in any color combination¹⁵.

Applicant's two marks opposed herein, both depict (and would be recognized as) rectangular flags. The rectangular flag design of Appln. No. 85/646,359 is a highly stylized version of the rectangular flag design of Appln. No. 85/646,316. As such, both marks are intended to and do give the same commercial impression – a rectangular flag with opposing shaded or colored panels¹⁶.

Applicant's website, www.andaleenergy.com, directly references and makes a play on Opposer's famous name and marks¹⁷.

Applicant's Opposed Marks so resemble Opposer's Red Bull Graphics Mark as to be likely, when applied to the goods of Appln. No. 85/646,316 and 85/646,359, respectively, to cause confusion, mistake or deception among purchasers, users, and the public, thereby damaging Red Bull.¹⁸

The goods on which Applicant asserts a bona fide intent-to-use Applicant's Opposed Marks are identical or very similar to, used for the same purposes, and/or are or will be advertised and promoted to and directed at the same trade channels, the same purchasers, and are or will be used in the same environment as Opposer Red Bull's products and related goods and services.¹⁹

Simultaneous use of Applicant's Opposed Marks on the goods set forth in Appln. Nos. 85/646,316 and 85/646,359, respectively, and the Red Bull Graphics Mark on its goods and related services as set forth above is likely to cause confusion, misstate or deception among purchasers, users, and the public, thereby damaging Red Bull.²⁰

Use by Applicant of Applicant's Opposed Marks on the goods set forth in Appln. Nos. 85/646,316 and 85/646,359, respectively, is likely to lead to the midstage belief that Applicant's products are sponsored by, affiliated with, approved by or otherwise emanate from Opposer Red Bull, thereby damaging Red Bull.²¹

The above listed facts are necessarily deemed admitted for the purposes of this motion.

Deeming Opposer's factual allegations above as true, Applicant has failed to show that there are no issues of material facts in regard to the similarities between Red Bull's Graphics Mark and Applicant's Mark, and Applicant's MPJP must be denied.

¹⁴ Complaint at ¶ 7.

¹⁵ *Id.* at ¶ 9.

¹⁶ *Id.* at ¶ 12.

¹⁷ *Id.* at ¶ 13.

¹⁸ *Id.* at ¶ 15.

¹⁹ Complaint at ¶ 16.

²⁰ *Id.* at ¶ 17.

²¹ *Id.* at ¶ 18.

B. Opposer's Notice of Opposition Raises Issues of Fact, Which, If Proved, Would Establish Opposer's Entitlement to Judgment

Applicant has stated that its MPJP focuses solely on the first *DuPont* factor; whether the mark of Appln. No. 85/646,359 is confusingly similar in appearance, sound, connotation, and commercial impression to the mark of Opposer's prior Reg. No. 2,829,269²². Applicant's MPJP does not examine the facts of pleadings at all and only describes its own opinion of some the elements of its own mark, baldly concluding that the mark of Appln. No. 85/646,359 ("Applicant's Mark") and Reg. No. 2,829,269 ("Red Bull's Graphics Mark") are different in appearance, sound, connotation, and commercial impression. However, a look at the factual allegations of the Complaint – all of which are deemed admitted for the purposes of this motion – show that the two marks are similar. Based on this, and taking all well-pleaded facts in the Complaint as true, Applicant has not established that a lack of material fact exists and the MPJP should be denied.

1. Based on the Pleadings, There is a Material Issue of Fact Regarding the Similarities between Applicant's Mark and Red Bull's Graphics Mark.

As stated in the pleadings – and therefore deemed true – Opposer is the owner of the Red Bull's Graphics Mark²³. From the picture of the mark in the Complaint, Red Bull's Graphics Mark consists of rectangle with opposing shaded or colored panels. Applicant's mark, according to the factual allegations of the complaint, is also a rectangle with the identical opposing shaded or colored panels²⁴. Further, the goods upon which Applicant intends to use Applicant's Mark are identical to Opposer's, and directed at the same trade channels and purchasers as Opposer's,²⁵ such that simultaneous use of Applicant's Mark (with its substantially similar

²² As the *DuPont* factors are irrelevant to a claim of false suggestion of a connection, Applicant entirely omits – and presumably simply elects to not address – Opposer's second claim of false suggestion of a connection. *See* Sec. C, *infra*, for a discussion of Applicant's passing mention of Opposer's second claim in the MPJP, and why the motion should be denied in regard to this claim as well.

²³ Complaint ¶ 2.

²⁴ Complaint at ¶ 2, 9, 12. As neither mark claims color as a feature of the mark, both cover all colors and are therefore for identical color schemes.

²⁵ *Id.* at 16.

background design) on its goods and Red Bull's Graphics Mark on its identical goods is likely to cause confusion among the public.²⁶ These basic similarities alone, based on the facts deemed admitted in the Complaint, show that, if proven, Opposer would be entitled to judgment, and as such, the MPJP must be denied.

Applicant argues that the additional elements of Applicant's Mark beyond its flag design with confusingly similar colored panels (a fact from the Complaint taken as true for the purposes of this motion)²⁷ makes Applicant's Mark so drastically different from Red Bull's Graphics Mark that there is no issue of material fact. However, given the long-term continuous use of Red Bull's Graphics Mark in the United States for many years prior to the filing of Applicant's Mark²⁸, and the extensive advertising and promotion of Opposer's energy drinks and related beverages under Red Bull's Graphics Mark, Red Bull's Graphics Mark has become well-known, and famous, in the United States and worldwide for energy drinks and related beverages – as pleaded in the Complaint and taken as true.²⁹ Due to the renown of this background design, Red Bull's Graphics Mark and other background designs that are substantially similar, such as the one in Applicant's Mark, are dominant over minor additional elements placed on top, and the additional matter added to Applicant's Mark does not eliminate this substantial similarity.

Based on the above, Opposer's well-pleaded facts in the Complaint, deemed admitted, show that Applicant's Mark is similar to Red Bull's Graphics Mark, such that, if proven, Opposer would be entitled to judgment as a matter of law. As such, Applicant has failed to show that no issue of material fact exists, and Applicant's MPJP must be denied.

C. Opposer's MPJP Deals Entirely With the Likelihood of Confusion Claim and does not Discuss the Claim of False Suggestion of a Connection.

²⁶ *Id.* at 17.

²⁷ *Id.* at 12.

²⁸ *Id.* at ¶¶ 1-4.

²⁹ *Id.* at ¶¶ 5-7.

Applicant's MPJP states in passing that "the differences between the marks are so great as to preclude a finding of false suggestion of a connection under Section 2(a)"³⁰, but neglects to provide any information whatsoever as to how it came to this self-serving conclusion from the pleadings. In fact, Applicant's entire argument deals with the first *DuPont* factor – whether Applicant's Mark and Red Bull's Graphics Mark are similar in appearance, sound, meaning, and commercial impression. This factor, and the *DuPont* test overall, are used only for a likelihood of confusion analysis – not for a false suggestion of a connection analysis, which uses the 4-part test set forth in *University of Notre Dam du Lac v. J.C. Gourmet Foods Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g* 213 USPQ 514 (TTAB 1982). In fact, the courts have long rejected the assertion that likelihood of confusion (under *DuPont*) is a condition precedent to finding false suggestion of a connection³¹. Additionally, Applicant is wholly incorrect that a claim of false suggestion of a connection deals with similarities between the marks. Rather, the claim is specifically a question of whether Applicant's mark consists of or comprises matter which may falsely suggest a connection with a person³², wherein a "person" may include a corporation or government entity³³. Here, Applicant omits any argument regarding whether, based on the facts as deemed admitted in the pleadings, a genuine issue of material fact exists on the issue of Applicant's Mark falsely suggesting a connection to Opposer. As such, Applicant has clearly not met its burden, and Applicant's MPJP must be denied in regard to Opposer's Sec. 2(a) claim.

Further, in reviewing the well-pleaded facts of the Complaint (all of which are deemed true for the purposes of this motion), Opposer has set forth a claim and facts, which, if proven, would entitle Opposer to judgment as a matter of law. Opposer sets forth the fame and renown

³⁰ MPJP at 7.

³¹ *University of Notre Dam du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ at 509.

³² 15 U.S.C. § 1052(a).

³³ *See In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009); and *In re Brumberger Co.*, 200 USPQ 475 (TTAB 1978).

of both Opposer and Red Bull's Graphics Mark (which as admitted by Applicant³⁴, is representative of Opposer)³⁵, as well as Applicant's direct references to Opposer's famous name and identity at Applicant's website³⁶. These facts – deemed true for the purposes of this motion – evidence that consumers would mistakenly recognize Applicant's Mark as pointing uniquely to Opposer, leading to the assumption that Applicant is connected with Opposer when Applicant's Mark is used on the identical goods as Opposer's goods. If proven, the facts of the Complaint establish Opposer's entitlement to judgment for false suggestion of a connection, and Applicant's MPJP must be denied.

CONCLUSION

For the foregoing reasons, by taking Opposer's relevant allegations as true (as is required under the rules when determining a motion for judgment on the pleadings), the Complaint clearly raises issues of fact, which, if proved, would establish Opposer's entitlement to judgment. On this basis, Applicant's MPJP should accordingly be denied.

Date: April 30, 2014

Respectfully submitted,
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³⁴ See MPJP at 7. As stated, a false suggestion of a connection claim deals with whether Applicant's mark falsely suggests a connection with Opposer. As Applicant only mentions in passing that, in its opinion, Applicant's Mark is so dissimilar to Red Bull's Graphics Mark as to preclude a finding of false suggestion of a connection, Applicant is necessarily conceding that, for the false suggestion of a connection claim, Red Bull's Graphics Mark is representative of Opposer.

³⁵ Complaint ¶¶ 5-7.

³⁶ *Id.* ¶ 13.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S FIRST MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS** is being served on April 30, 2014, by first class mail, postage prepaid on Applicant's Correspondent of Record at the Correspondent's address of record below, with courtesy copy via email to Paulo@patelalmeida.com and Alex@patelalmeida.com:

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